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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/498,515

02/04/2000

Howard G. Page

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05/29/2009

SPRINT

6391 SPRINT PARKWAY

KSOPHT0101-Z2100

OVERLAND PARK, KS 66251-2100

EXAMINER

RETTA, YEHDEGA

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

05/29/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/498,515	<b>Applicant(s)</b> PAGE ET AL.	
	<b>Examiner</b> Yehdega Retta	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5,7,8,10-12,17,18,20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 7, 8, 10-12, 17, 18, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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### DETAILED ACTION

This office action is in response to amendment filed March 11, 2009. Currently claims 1, 5, 7, 8, 10-12, 17, 18, 20 and 21 are pending.

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites determining an *insertion point* in the selected video content for the selected video advertising, wherein the *insertion point comprises data indicating where in the selected video content the selected video advertising is to be inserted*;

Applicant specification teaches as follows:

The scheduler 212 transfers the selected video content 201 to the television 221 over the link 203. The television 221 displays the selected video content 201 to the target viewer 220. When the scheduler 212 encounters an insertion point for the selected video content 201, the scheduler 212 interrupts the transfer of the selected video content 201 and retrieves the corresponding selected video advertising 213 from the video storage 214 over the link 215. The scheduler then transfers the selected video advertising 213 to the

FIG. 3 is a logical table that illustrates a viewer profile data structure 330 within the processing system 211. The processing system 211 enters the viewer profile data structure 330 with profile information for the target viewer (V1, V2 ... VN) and proceeds through the table using the selected video content (C1, C2 ... CN) to yield the selected video advertising (A1, A2 ... AN) and corresponding insertion points (T1, T2 ... TN).

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As shown above the specification teaches an insertion point where the advertisement is to be inserted. In light of applicant's invention the insertion point itself indicated that the advertisement is to be inserted in the insertion point. This is different than the insertion point including data which indicated where the advertising is to be inserted.

Claim 12 is also rejected for the same reason stated above.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, 7, 8, 10-12, 17, 18, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swix et al. U.S. Patent No. 6,718,551, in view of Zigmond et al. (US 6,698,020) in view of "NDS: NDS' XTV(TM) time shifting technology empowers the viewer and the broadcaster", M2 Presswire, Sep 10, 1999, (hereinafter XTV(TM)) and further in view of Eyer et al. (US 6,588,015).

Regarding claims 1, 7, 8, 11, 12, 17, 18 and 21, Swix teaches selecting video advertising (e.g. pickup trucks) that has a subject matter relation to the selected video content ( e.g. western movies) requested by the target viewer (see col. 9 line 33 to col. 10 line 34); transferring the selected video content to the a target viewer device over a first transport system and transferring the selected video advertising to the target viewer device over a second transport system, wherein the first transport system uses greater bandwidth for video transfer than the second transport system (see col. 12 line 21 to col. 13 line 23). Swix teaches delivering bit map or video

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advertisements and storing the advertisement in the viewer device and retrieving the advertisement for insertion in an advertisement slots (see col. 11 line 34 to col. 12 line 60). Swix teaches insertion of the advertisements at predetermined slots in a continuous broadcasting program *wherein the insertion points comprising data indicating where in the selected video content the selected video advertising is to be inserted (see fig. 5) (the slots are indication of where the advertisements are to be inserted)* . Swix also teaches the insertion of advertisement before and after the presentation of a video content but failed to explicitly teach interrupting the transferring of the video content in the video stream at the insertion point; retrieving the selected video advertising from the video storage; inserting the selected video advertising into the video stream; resuming the transferring of the selected video content in the video stream at the insertion point, it is taught in Zigmond (see fig. 3-6, col. 6 lines 13-29, col. 7 lines 1-25 and col. 17 lines 10-32). It would have been obvious to one of ordinary skill in the art at the time of the invention to store the advertisement locally and to interrupt the video programming at the appropriate time to play selected advertisement in Swix's media delivery system to increase the display of advertisements as a financial incentive to encourage the service provider to provide the service to the viewers. Swix does not teach disabling fast-forward capability when the selected video advertising is displayed. XTV(TM) teaches a set-top-box which provides advertisers with the ability to totally prevent views from skipping ads. It would have been obvious to one of ordinary skill in the art at the time of the invention to disable the ability of fast-forward or skip forward in order to force the subscriber to view the commercials (see page 1). STV(TM) does not explicitly indicate how ads are skipped. Eyer teaches that it is possible to force subscriber to listen to certain commercials by disabling the ability to FAST FORWARD or

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SKIP FORWARD (see col. 7 line 50 to col. 8 line 12 and col. 16 lines 37-54). It would have been obvious to one of ordinary skill in the art at the time of the invention to disable the fast-forward or skip forward function of the set-top box of Swix, as taught in Eyer, to provide the advantage of preventing ad skipping function, as taught in STV(TM). *Swix teaches the broadcasting server delivers the continuous broadcast program in one channel and delivers other programs and advertisements in other channels (see col. 12 lines 61-66). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to transmit the non-continuous broadcast program such as the insertion point or signal to instruct the head-end or the set-top to automatically switch to the specific program (see col. 13 lines 1-8).*

Regarding claim 5, Swix teaches selecting the video ad based on a viewer profile for the target viewer (see col. 7 line 31 to col. 8 line 2, col. 8 line 66 to col. 9 line 44)

Regarding claims 10 and 20, Swix does not explicitly teach re-displaying the selected video advertisements after rewinding the video content. It would have been obvious for Swix to re-display the same advertising since the advertisement selected is cached at the client set-top box and is inserted into the video stream, locally at a client side, and presented to the viewer.

### ***Response to Arguments***

Applicant's arguments filed March 11, 2009 have been fully considered but they are not persuasive.

Regarding the 101 rejection applicant argues that the application teaches that the insertion points are more than just the points themselves within the video content at which the video advertising is to be inserted, since the insertion points *are transported separately* from the

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selected video content 201. As indicated by applicant the specification teaches that the "*The processing system 211 transfers the insertion points to the scheduler 212 over either the transport system 202, or the transport system 204 through storage 214 and link 215*". Just because the insertion points are transported separately from the selected video content does not mean the insertion points are more than just the points themselves. Applicant also indicates that "[w]hen the scheduler 212 encounters an insertion point for the selected video content 201, the scheduler 212 interrupts the transfer of the selected video content 201 and retrieves the corresponding selected video advertising 213 from the video storage 214 over the link 215. The scheduler then transfers the selected video advertising 213 to the television 221 over the link 203." Applicant argues "thus, the insertion points of Fig. 3 indeed "indicat[e] where in the selected video content the selected video advertising is to be inserted,"". Examiner respectfully disagrees. First of all nowhere in the specification does it teach that the insertion points includes data that is more than just the points themselves within the video content at which the video advertising is to be inserted, as indicated by applicant. Applicant's specification teaches "(t)he processing system 211 responds to the request by selecting particular video advertising 213 to insert based on the identity of the target viewer 220 and the selected video content 201 that is requested by the target viewer 220. The processing system 211 also determines insertion points in the selected video content 201 for the selected video advertising 213". Applicant's specification also teaches (T1, T2,... TN), as insertion points for the advertisements. The specification however does not teach the insertion point comprises data indicating where in the selected video content the selected video advertising is to be inserted (i.e., more than just the points themselves, as argues by applicant).

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Applicant also argues that neither Swix nor Zigmond teaches or suggests transferring the insertion point to the target viewer device over the second transport system and nor does the Office action appear to address this provision. Examiner disagrees. The office action indicates that Swix teaches the broadcasting server delivers the continuous broadcast program in one channel and delivers other *programs and advertisements in other channels* (see col. 12 lines 61-66). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to transmit the *non-continuous broadcast program such as the insertion point or signal to instruct the head-end or the set-top to automatically switch to the specific program* (see col. 13 lines 1-8).

Applicant also indicates that "(t)he Office further indicates that Swix teaches an insertion point comprising *"data indicating where in the selected video content the selected video advertising is to be inserted,"* as provided for in claims 1 and 12, specifically by way of Fig. 5 of Swix, and indicating that "the slots are indication[s] of where the advertisements are to be inserted." Applicant asserts that the advertising slots 516 themselves do not indicate where in the selected video content the selected video advertising is to be inserted. Applicant argues that the functionality is borne by the q-tone *signals* noted above that accompany the normal broadcast transmission, and thus are not data and are not transported over a separate transport system.

Examiner would like to point out that the specification teaches as follows:

The processing system 211 also **determines insertion points in the selected video content 201** for the selected video advertising 213. The processing system 211 transfers the insertion points to the scheduler 212 over either the transport system 202, or the transport system 204 through storage 214 and link 215.

The video-on-demand system 200 also transfers the **selected video advertising 213 over the transport system 204** to the video storage 214. If desired, the video storage 213 could provide a cache to avoid the transfer of previously transferred video advertising 213 held in the cache. In alternative embodiments, the video-on-demand system 200



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could transfer the selected video advertising 213 to the video storage 214 using spare transport capacity in the transport system 202.

The scheduler 212 transfers the selected video content 201 to the television 221 over the link 203. The television 221 displays the selected video content 201 to the target viewer 220. **When the scheduler 212 encounters an insertion point for the selected video content 201, the scheduler 212 interrupts the transfer of the selected video content 201 and retrieves the corresponding selected video advertising 213 from the video storage 214 over the link 215.** The scheduler then transfers the selected video advertising 213 to the television 221 over the link 203. The television 221 displays the selected video advertising 213 to the target viewer 220.

Swix, same as applicant's invention, teaches as follows:

The broadcast advertisement insertion method **inserts targeted advertisements at a predetermined advertisement insertion slots in a continuous broadcast program.** The broadcast server 105 delivers the continuous **broadcast program in one channel and delivers other programs and advertisements in other channels.** By this method, when an advertisement slot comes up, file server 102 directs each set-top box to switch for the duration of the advertisement insertion slot from the continuous broadcast program to a channel running an advertisement targeted for the individual subscriber of each set-top box.

*The separate advertisement channel can be either another programming channel whose advertisement insertion slots coincide with program broadcast 500 or can be a continuous stream of advertisements with no programming. The continuous stream of advertisements is preferred if the intervals of the advertisements line up with the programming channels that switch to it.*

Therefore, Swix teaches the advertisement, which is transmitted in a separate transportation channel, also includes an insertion slots (insertion points) transferred with the advertisement (second transport channel) which coincides with the program broadcast.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR  
/Yehdega Retta/  
Primary Examiner, Art Unit 3622

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